

REMARKS

The present Amendment Response is responsive to the non-final Office Action mailed January 4, 2006. By this Amendment, Claims 34-37, 39, 40, 47-50, 52, and 53 have been amended and Claims 38, 45, 46, 51, 58, and 59 have been canceled. Claims 1- 33 were previously canceled in a preliminary amendment. Reconsideration and allowance of the application, as amended, is requested.

Claim Rejection Under 35 U.S.C. § 102

In the non-final Office Action, Claims 34-40 and 47-53 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,699,528 to Hogan et al. (hereafter referred to as "Hogan"). With respect to independent Claims 34 and 47, the Office Action alleges that Hogan discloses, among other features, "directing payment of the second bill without transmitting a notice of availability of electronic presentment of at least a portion of the second billing information." In support of this position, the Office Action looks to Hogan, col. 5 lines 62 to col. 6, lines 1-30, because "the user can log into the EBSC [electronic bill service company] website to pay his or her bill." Applicants respectfully traverse this rejection for at least the reasons set forth below.

As amended, independent Claims 34 and 47 similarly recite that payment of the second bill is automatically directed by the service provider on behalf of a second consumer without transmitting a notice of availability of at least a portion of the second billing information to the second consumer, where payment of the first and second bills are automatically directed without the service provider receiving a request to pay the respective bill. As described by the specification of the present invention, the notice of availability can be received by the consumer as an e-mail or directly in the bill presentment client. (page 15, lines 13-15).

However, the system in Hogan does not teach or suggest that payments can be automatically directed by the service provider on behalf of a consumer, where payment of the bill is automatically directed without the service provider receiving a request to pay the bill. Instead, in the Hogan system, payment of a bill is directed by the subscriber, and thus is not automatically directed by the service provider without the service provider receiving a request to pay the bill. More specifically, in the first of two embodiments of the Hogan system, a

subscriber visits a EBSC bill payment web site and provides authenticating credentials (col. 5, line 62-col. 6, line 8). Once authenticated, the subscriber is presented with several choices, including "Receive and Pay Bills" 203. (col. 6, line 14). If "Receive and Pay Bills" 203 is selected, the program proceeds to step 315 of FIG. 2B, where the subscriber is shown the image of the first unpaid bill of FIG. 4. (col. 6, lines 21-25). After being shown the image of the unpaid bill, the subscriber can select a payment option to pay the bill. (col. 6, lines 31-33; steps 320-375 of FIG. 2B; and "Pay Date" 407, "Payment Method" 409, and "Amount" 411 of FIG. 4). Similarly, in the second embodiment of the Hogan system, the customer instructs the system to make a payment after receiving an electronic bill that is transmitted to the subscriber's email address. (col. 9, lines 7-14 and lines 52-54). When the electronic bill is opened by the subscriber, the server computer receives an acknowledgement receipt from the e-mail service. (col. 9, lines 61-64). As shown in FIGs. 8A and 8B, upon invoking the electronic bill payment program, the program determines whether there are unopened bills. Only after the bill has been opened / viewed can the subscriber choose pay the bill. ("Unopened Bills?" 801 in FIG. 8A must be satisfied in order to proceed to "List Open and Unpaid Bills" 817 and "Pay Bill?" 823 in FIG. 8B). Accordingly, in both embodiments of Hogan, the subscriber pays the bill after being presented with the bill. Thus, the Hogan system does not teach or suggest this "automatically directing payment of the second bill by the service provider" feature of Claims 34 and 47 because the subscriber directs payment of the bill instead of the service provider. Accordingly, independent Claims 34 and 47 are allowable over Hogan.

Further, it would not have been obvious to modify Hogan in view of U.S. Patent No. 5,956,700 to Landry (hereafter referred to as "Landry") such that payment of the second bill is automatically directed by the service provider on behalf of a second consumer without transmitting a notice of availability of at least a portion of the second billing information to the second consumer. Indeed, Landry actually teaches away from the claimed feature of "without transmitting a notice of availability of at least a portion of the second billing information to the second consumer." That is, the system of Landry would not work as desired if the payors were not properly notified of the billing information. Indeed, the payors in Landry would have to be properly notified of the billing information in order to have "significant control over payments and a mechanism to fully or partially reverse payments made by the system within an applicable

provisional period,” as desired by the Landry system (col. 6, lines 61-68 (emphasis added)). Similarly, none of the prior art systems described in the background of Landry cure such a deficiency. In particular, the “negative action bill payments” described in Landry and relied upon by the Office Action occur only after the bill has been delivered to the payor. (*See* col. 1, lines 46-55 (stating that “Once a bill is delivered to the payor it is usually the responsibility of the payor to deliver payment to the payee....Bill payment may be classified into two very general categories, positive and negative.”)). Accordingly, it would not have been obvious to modify Hogan in view of Landry such that payment of the second bill is automatically directed by the service provider on behalf of a second consumer without transmitting a notice of availability of at least a portion of the second billing information to the second consumer. Thus, independent Claims 34 and 47 are allowable.

Moreover, independent Claims 34 and 47 are further patentable over Hogan and Landry because Claims 34 and 47 recite features that would not have been expected in view of Hogan and Landry. In particular, these unexpected features recited in Claims 34 and 47 include a notice being to be transmitted to the first consumer while no notice is transmitted to the second consumer. Where the first and second consumers are different, this includes the first consumer receiving a notice and the service provider automatically directing payment for the first consumer while a second consumer does not receive a notice and the service provide still automatically directs payment for the second consumer. However, where the first and second consumers are the same, this includes, for a first biller, the consumer receiving the notice and the service provider directing payment of that first bill while for a second biller, the service provider directing payment of a second bill without providing the notice to the consumer. Indeed, such novel and non-obvious features are not taught or suggested anywhere in Hogan or Landry. Accordingly, Claims 34 and 47 are further allowable over Hogan and Landry.

Dependant Claims 35-37, 39-44 and 48-49, 52-57, which ultimately depend from independent Claims 34 and 47, are allowable for at least the reasons discussed above, notwithstanding their independent recitation of patentable features.

Applicant: Kitchen, et al.
Filed: June 25, 2003
Application No.: 10/602,688

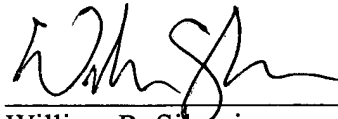
Claim Rejection Under 35 U.S.C. § 103

In the Office Action, Claims 41-44, 45-46, 54-57, and 58-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hogan in view of Landry. As described above, currently pending dependent Claims 41-44 and 54-57 are allowable as depending from allowable independent claims, notwithstanding their independent recitation of allowable features. Accordingly, this rejection under 35 U.S.C. § 103 is now moot.

CONCLUSION

It is not believed that extensions of time or fees for addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



William R. Silverio
Attorney for Applicants
Registration No. 45,383

SUTHERLAND ASBILL & BRENNAN, LLP
999 Peachtree Street, NE
Atlanta, GA 30309-3996
(404) 853-8214
(404) 853-8806 (fax)
SAB Docket No.: 23952-0032